

REMARKS

In the Office Action mailed September 17, 2002, Claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,079,028 issued to Emmons et al. Claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/30425 in the name of Martz et al. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-16 of copending application SN 10/091,960.

I. Rejections under 35 U.S.C. §103(a)

A. Rejections over Emmons et al.

Claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,079,028 issued to Emmons et al. Applicants respectfully disagree with the Examiner's contention regarding Emmons et al.

The Examiner admits at page 2 of the instant Office Action that, "(t)he degree of picking and choosing required to arrive at the instantly claimed invention is sufficient to remove this reference from the scope of an anticipating reference under the relevant caselaw, such as but not limited to *In re Baird*." Although Applicants agree with the Examiner that *In re Baird* is applicable to the instant rejections, they believe that the Examiner is slightly misstating the holding of that case. *In re Baird* dealt with obviousness rejections over a generic description of a large genus of compounds. The Federal Circuit, in overturning the Board of Patent Appeals and Interferences, held that there was too much picking and choosing required to sustain an obviousness, not anticipation, rejection thusly, "(w)hile the ... formula unquestionably encompasses (the claimed compound) when specific variables are chosen, there is nothing in the disclosure ... suggesting that one should select such variables." (16 F.3d 380,382, 29 U.S.P.Q.2d 1550,1552 (Fed. Cir. 1994)). Here, the Examiner has failed to point to where Emmons et al. provides guidance to one of ordinary skill in the art to select variables which would lead him or her to the instantly claimed invention.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found

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either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).

Clearly, there is no such teaching, suggestion or motivation shown in the reference in this case. Therefore, Applicants contend that nothing in the teaching of Emmons et al. would lead one of ordinary skill to the instantly claimed invention and respectfully request the Examiner reconsider and reverse the rejection of Claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,079,028 issued to Emmons et al.

B. Rejections over Martz et al.

Claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/30425 in the name of Martz et al. Applicants respectfully disagree with the Examiner's contention regarding Martz et al.

The Examiner states in the paragraph spanning pages 3 and 4 of the instant Office Action that, "(I)t would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination of ingredients to form the thickener of Martz because the patentee clearly encompasses such mixtures of reactants and the instantly claimed combination of ingredients would have been expected to give the thickening properties discussed by Martz."

Applicants respectfully remind the Examiner of the Federal Circuit's admonition in *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998), that

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, **the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.** (Emphasis added.)

Applicants respectfully contend that the Examiner has failed to do so in the instant Office Action.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).

Clearly, there is no such teaching, suggestion or motivation shown in the reference in this case. If the Examiner is relying on knowledge generally available to one of ordinary skill in the art, MPEP §2144.03 states that if Applicants traverse such an assertion, the Examiner should cite a reference in support of his position. Applicants do traverse the Examiner's assertion in this case and hereby request such a reference. If the Examiner is relying on facts within his personal knowledge, applicants respectfully request and are calling for, pursuant to MPEP §2144.03 and 37 C.F.R. §1.104, the Examiner to support such facts by an Affidavit.

Therefore, Applicants contend that nothing in the teaching of Martz et al. would lead one of ordinary skill to the instantly claimed invention and respectfully request the Examiner reconsider and reverse the rejection of Claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over WO 96/30425 in the name of Martz et al.

II. Rejections under judicially created doctrine of obviousness-type double patenting

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-16 of copending application SN 10/091,960.

Although Applicants disagree with the Examiner's contention regarding the instantly claimed invention and Claims 1-16 of copending application SN 10/091,960, Applicants request the Examiner hold this rejection in abeyance until such time as Claims 1-16 of copending application SN 10/091,960 are patented.

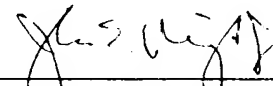
CONCLUSION

Applicants have amended Claims 1-12. Such amendment is to be construed as "truly cosmetic" and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation, v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.* 122 S. Ct. 1831; 152 L. Ed. 2d 944; 62 U.S.P.Q.2D (BNA) 1705. Applicants further contend that such amendments add no new matter and find support in the specification. Attached hereto, please find pages captioned "Version with markings to show changes made."

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-12. If the Examiner is of the opinion that the instant application is in condition for other than allowance, he is requested to contact the Applicants' attorney at the telephone number given below so that additional changes to the claims may be discussed.

Respectfully submitted,

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Version with markings to show changes made

In the claims:

The claims have been amended as follows:

1. (Amended) A water-soluble or water-dispersible polyurethane comprising a reaction product of

- A) a mixture of at least one polyether polyol a1) having an average functionality of ≥ 3 and at least one urethane group-containing polyether polyol a2) having an average functionality of ≥ 4 ,
- B) at least one C₈-C₂₂ monoisocyanate ~~having 8 to 22 carbon atoms,~~
- C) at least one (cyclo)aliphatic and/or aromatic diisocyanate,
- D) optionally at least one C₈-C₂₂ monoalcohol ~~having 8 to 22 carbon atoms, and~~
- F) optionally at least one polyisocyanate having an average functionality of > 2

wherein the starting NCO/OH equivalent ratio is between 0.5:1 to 1.2:1.

2. (Amended) The polyurethane of claim Claim 1, wherein the polyether polyol a1) has an average functionality of 3.

3. (Amended) The polyurethane of claim Claim 1, wherein the polyether polyol a1) has an average functionality of 4 to 6.

4. (Amended) The polyurethane of claim Claim 1, wherein monoisocyanate component B) ~~has 10 to 18 carbon atoms~~ comprises a C₁₀-C₁₈ monoisocyanate.

5. (Amended) The polyurethane of claim Claim 1, wherein monoisocyanate component B) ~~has 12 to 18 carbon atoms~~ comprises a C₁₂-C₁₈ monoisocyanate.

6. (Amended) The polyurethane of claim Claim 1, wherein diisocyanate component C) ~~is~~ comprises a (cyclo)aliphatic diisocyanate.

7. (Amended) The polyurethane of claim Claim 1, wherein monoalcohol component D) contains 10 to 18 carbon atoms comprises a C₁₀-C₁₈ monoalcohol.

8. (Amended) A process for the production of a water-soluble or water-dispersible polyurethane comprising reacting

- A) a mixture of at least one polyether polyol a1) having an average functionality of ≥ 3 and at least one urethane group-containing polyether polyol a2) having an average functionality of ≥ 4 ,
 - B) at least one C₈-C₂₂ monoisocyanate ~~with 8 to 22 carbon atoms~~,
 - C) at least one (cyclo)aliphatic and/or aromatic diisocyanate,
 - D) optionally at least one C₈-C₂₂ monoalcohol ~~with 8 to 22 carbon atoms~~, and
 - E) optionally at least one polyisocyanate having a mean functionality of > 2
- wherein the starting NCO/OH equivalent ratio is between 0.5:1 to 1.2:1..

9. (Amended) The process of claim Claim 8, wherein the urethane group-containing polyether polyol a2) is produced by a partial reaction of the polyether polyol a1) with a diisocyanate.

10. (Amended) The process of claim Claim 8, wherein the urethane group-containing polyether polyol a2) is produced by a partial reaction of the polyether polyol a1) with polyisocyanates having an average functionality of ≥ 2 .

11. (Amended) A composition of matter comprising the polyurethane of claim Claim 1.

12. (Amended) The composition of claim Claim 11, wherein the composition is a thickened aqueous paint system, an adhesive or another aqueous formulation.